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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,595	03/17/2004	Takehiro Ikeda	250520US90	4182

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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT PAPER NUMBER

2617

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/801,595

Applicant(s)

IKEDA ET AL.

Examiner

Stephen M. D'Agosta

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 7 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The examiner acknowledges the changes made to the claims (USC 112 problems) and Abstract. Thank you.

2. Regarding the IDS, the examiner requested fully translated documents so that he could review them in their entirety. While the applicant is correct (per the MPEP) that they are not required, the examiner notes that only an interpretation of the art in question was actually provided (eg. from the foreign office action as per applicant's response). Therefore the examiner does not have a full working knowledge of these documents.

3. The applicant argues that the prior art does not teach "...selection means that selects a communication subsystem whereby the current location can be measured with the greatest accuracy...". The examiner disagrees – first and foremost, the claims do not recite that there must always be a situation when a selection is required (eg. that there must always be multiple positioning systems available and that the mobile determines its location with every positioning system possible before making a selection). The claim merely states that the mobile selects the system with the greatest accuracy, hence when only one system is available, that is the system that is used/selected. The applicant is invited to amend their claims to address this important point (eg. add verbeds such that they state when multiple systems are available, the mobile device contacts each system and determines which one provides the most accuracy).

Furthermore, the examiner notes that since Whinnet clearly discloses that he understands which positioning systems provide better accuracy (see pages 6-7), the simple fact is that Whinnet would prioritize the available positioning systems he uses (in real time) to always choose the most accurate.

Lastly, the examiner notes that Whinnet is highly aware of the accuracy of the positioning systems, "Obviously, the greater the accuracy of the geo-location process, the more accurate will be the selection of the local system, and the more efficient will be the provision of the BBS system" (see page 7, L16-20). A reasonable engineer would conclude that Whinnet's system would not operate in the most optimal manner if he doesn't select the most accurate positioning system available.

4. The applicant argues that the prior art does not teach "...transmission means that measures said current location using the communication subsystem selected by said selection means and transmits the result of determination of said usability by said determination means, together with information indicating said current location, using the communication subsystem selected by the selection means....". The examiner disagrees since Whinnet teaches the mobile user measuring/testing and selecting a communication system (see figure 2 and page 9, L31 to page 10, L7). Note this describes the mobile deciding which system to select. The examiner notes that it is also well known for the mobile to send data to the network/BTS whereby said network/BTS decides which network the mobile should connect to (eg. MAHO handoff, see page 10, L5). Therefore, the examiner notes that this is a design consideration and not novel in the art.

As noted, Whinnet's system requires either the mobile or the network to determine the user's location such that said user can filter/receive pertinent bulletin board information. The examiner notes that Whinnet's system appears more focused on the mobile unit acting autonomously, Whinnet allows for variations/modifications to his design (see page 11, L34-38). Therefore, the examiner concludes that it is within the spirit and scope of Whinnet's "embracing of alterations, modifications and variations", to support a design whereby the network would provide location services (and not require the mobile to send them to the network). This again is similar to the above-described handoff operations whereby the mobile and/or the network can perform the bulk of the work.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6 rejected under 35 U.S.C. 102(b) as being anticipated by Whinnet et al. GB-2313257.

As per **claim 1**, Whinnet teaches a mobile unit that is capable of communication using a plurality of communication subsystems (abstract and figure 1 show mobile unit communicating with multiple wireless networks), characterized in that it comprises:

determination means, at the mobile, that determines usability (eg. availability) of the plurality of communication subsystems at the current location of said mobile unit (figure 2, #33 teaches receiving an indication of available communication systems);

selection means that selects a communication subsystem whereby the current location can be measured with the greatest accuracy, of the communication subsystems that are determined as usable by said determination means (page 6, L28 to C7, L27 teaches using either active or passive location determination); and

transmission means that infers/transmits said current location using the communication subsystem selected by said selection means and transmits the result of determination of said usability by said determination means, together with information indicating said current location, using the communication subsystem selected by said selection means (page 6, L8-18 teaches sending information from mobile to server/bulletin board).

With further regard to claim 6, Whinnet teaches

a reception step for receiving the determination result of said usability transmitted in said transmission step, together with information indicating said current location (page 6, L8-18);

a storage step of storing in storage means in updateable fashion as geographical information the result of determination of said usability received in said reception step,

in correspondence with information indicating said current location (page 6, L8-17 teaches the bulletin board receiving information from the mobile and extracting irrelevant data, hence the system must inherently store the received mobile data in order to keep itself updated with where the mobile is/was).

a communication subsystem specification step of specifying a communication subsystem that can be used at said current location or at a location designated by said mobile unit, by looking up the geographical information stored in said storage means; and a notification step of notifying said mobile unit of a usable communication subsystem specified in said communication subsystem specification step, in response to a request from the mobile unit (C6, L15-18)..

As per **claim 2**, Whinnet teaches claim 1 and a server (eg. bulletin board) characterized in that it comprises:

communication means that receives the result of determination of said usability transmitted by the transmission means of the mobile unit according to claim 1, together with information indicating said current location; (page 6, L8-18); and

storage means that stores in updateable fashion the result of determination of said usability received by said communication means as geographical information, in correspondence with information indicating said current location (page 6, L8-17 teaches the bulletin board receiving information from the mobile and extracting irrelevant data, hence the system must inherently store the received mobile data in order to keep itself updated with where the mobile is/was).

As per **claim 3**, Davenport teaches claim 2 characterized in that, it further comprises communication subsystem specification means that specifies a communication subsystem that is usable at said current location or at a location designated by said mobile unit, by looking up the geographical information stored in said storage means; and, said communication means notifies said mobile unit of the usable communication system specified by said communication system specification means, in response to a request from the mobile unit (C6, L15-18).

Allowable Subject Matter

1. **Claims 4-5** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 4: The prior art of record, either alone or in combination, does not recite: region specification means that specifies a geographical region to which the current location belongs, based on information indicating said current location received by said communication means; and storage means that stores in updateable fashion as frequency-of-use information the number of times per unit time that a usability determination result has been received by said communication means, in correspondence with the usable communication subsystem indicated by determination result and geographical region specified by said region specification means.

Claim 5: Depends from claim 4 and is therefore allowable as well.

2. **Claim 7 allowed.** The prior art of record, either alone or in combination, does not recite:

a region specification step of specifying a geographical region to which the current location belongs, based on the information indicating said current location received in said reception step; a storage step of storing in storage means in updateable fashion as frequency-of-use information the number of times per unit time that the result of determination of usability has been received in said reception step, in correspondence with the usable communication subsystem indicated by said determination result and the geographical region specified in said region specification step; a frequency specification step of specifying the frequency-of-use of the each communication subsystem in the geographical region to which said current location or the location designated by said mobile unit belongs, by looking up the frequency-of-use information stored in said storage means; and a notification step of notifying said mobile unit of the frequency-of-use specified in said frequency specification step, in response to a request from the mobile unit.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

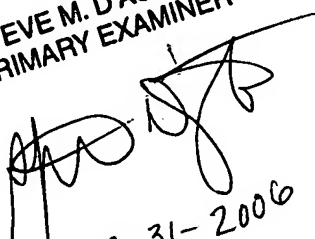
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

STEVE M. D'AGOSTA
PRIMARY EXAMINER


3-31-2006